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REMARKS

Claims 1, 7, 8, 11, 12 and 15 remain herein. Claims 3, 4, 6, 9, 10, 13 and 14 remain herein but are currently withdrawn from consideration. The subject matter of dependent claims 2 and 5 have been added to independent claim 1, and claims 2 and 5 have therefore been cancelled. Thus the number of claims herein has been reduced, and no new limitations or claims have been added.

This amendment is believed to place the claims of this application fully in condition for allowance, and surely places them in better condition for any appeal. Accordingly, entry of this amendment and allowance of all claims 1, 7, 8, 11, 12 and 15 are respectfully solicited.

1. Claims 1, 2, 5, 8, 11 and 12 were rejected under §103(a) over Peters U.S. Patent 6,093,112 in view of Besnard U.S. Patent 5,643,112.

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Applicants' independent claim 1, as now amended, specifies that each iron of the claimed set has a head having at least one recess in the upper wall opening onto the rear face of that upper wall and being elongate in the main direction of that upper wall, with the volume of the recess varying from one iron to another within the set to cause the center of gravity of each club head to vary from one iron to another within the set. Neither Peters nor Besnard discloses or teaches anything which would suggest applicants' claimed invention.

It is significant that the Office Action expressly admits that Peters lacks the following elements of applicants' claims:

Peters lacks at least one recess in the upper wall and said at least one recess opens onto a single face of an upper wall, away from the upper and lower faces, recess being elongated in a main direction of an upper wall, a volume of the recess being between .4 and 5% of the volume of the head, at least one of volume and a position of said at least one recess inside an upper wall varies in distance relative to an upper face from one iron to another within a set causing a [center of] gravity of each head to vary in distance relative to an upper face from one iron to another, and the number of recesses or volume of recesses decreasing from long irons to short irons.

Office Action, 12/2/03, pages 3-4; emphasis added here.

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Immediately before that array of admissions, the Office Action first makes another admission:

Peters does not specifically state that adding additional recesses or additional volume of recesses with weight inserts as shown between figures 20 and 22 would change the center of gravity....

But then, without any basis in the Peters reference, the Office Action proceeds to subsume applicants' disclosed and claimed invention into the prior skill in the art.

Immediately after the earlier quoted array of admissions, the Office Action, without citing any basis in Peters itself, assumes facts to conclude that:

It would have been obvious to modify the set of irons of Peters to have at least one of volume and a position of said at least one recess inside a lower wall varies in distance relative to an upper face from one iron to another within a set to cause a center of gravity of each head to vary in distance relative to an upper face of an upper wall from one iron to another and the number of recesses or volume changing from long irons to short irons in order to have weights added more protected by being in an insert compared to being attached to a sole as show in figure 3 of Peters.

Office Action, 12/2/03, page 4.

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These conclusions are not only without any basis in the Peters reference, but are inconsistent with the admissions made in the preceding paragraph of the Office Action, and are completely irrelevant with respect to the subject matter, for example, of applicants' claim 2, whose limitation is now incorporated into applicants' independent claim 1.

Although Peters generally raises vertical positions of the centers of gravity from the number 1 iron to the pitching wedge (column 15, lines 40 and 41), Peters does not teach or suggest that this is accomplished by varying a volume of at least one recess in the upper wall of the club head from one iron to another within the set. Peters discloses only that weight inserts 174 and 176 or 178 are provided in the lower wall of club heads making up only a specific sub-set of grouping of irons (second group 158) within the set. Peters does not teach complete club heads having a recess; inserts are attached to form the complete club head; there is no opening or cavity at the location of such inserts in the complete club head.

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There is simply no disclosure or teaching anywhere in Peters that would have suggested applicants' presently claimed invention to one of ordinary skill in the art.

Besnard discloses a golf club iron wherein "the upper edge portion includes an elongated recess 3 ... which increases in the direction of the toe of the club head" (col. 3, lines 34-36). However, even though Besnard discloses an iron having at least one recess in the upper wall, Besnard fails to teach or suggest that a volume of such recess varies from one iron to another within the set, as is recited in applicants' claim 1.

The Office Action also expressly admits that "Besnard does not specifically disclose the volume of the recesses compared to a head volume...." Office Action, 12/03/03, page 4. But, immediately thereafter, the Office Action, again without citing any specific basis in the prior art (because there is none), assumes:

but clearly an artisan skilled in forming a head with a low center of gravity using recesses in an upper wall would have selected a suitable volume for the recesses in which a volume of the recess being between .4 and 5% of the volume of the head is included.

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- Office Action, 12/2/03, page 4. This is "clearly" nothing more than an unlawful reading into the cited reference the very subject matter of applicants' claim 8 -- which the Office Action earlier specifically admits is not in the prior art.

The assumptions in the Office Action, unsupported by the evidence of record, continue:

In view of the patent of Besnard it would have been obvious to modify the set of irons of Peters to have at least one recess in the upper wall instead of the lower wall....

Office Action, 12/2/03, page 4. Why? Nothing in either Peters or Besnard teaches or suggests any need or desirability of such a modification.

Indeed, the use of weight inserts in the lower wall in Peters teaches away from the use of recesses in the upper wall as recited in applicants' claim 1. The use of inserts in golf club heads is the opposite of using recesses; the inserts add material and thus weight to a club head, while recesses omit material and thereby remove weight from the club head. Thus, there would be no suggestion or motivation for one skilled in the art to add a recess as in Besnard to the club head of Peters since Peters

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teaches diametrically away from the use of recesses by instead adding inserts to his club heads.

In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claims invention.

Karsten Mfg. Co. v. Cleveland Golf Co., 242 F.3d 1376, 58 USPQ2d 1285, 1293 (Fed.Cir. 2001). The Office Action points to no such suggestion, motivation or teaching in the prior art of record here.

That same paragraph bridging pages 4 and 5 of the Office Action, also assumes that it would have been obvious to modify Peters to have at least one recess in a single face of the upper wall wherein

volume ... of said at least one recess inside an upper wall varies in distance relative to an upper face from one iron to another within a set causing a [center of] gravity of each head to vary....

Office Action, 12/3/03, page 5. But, utterly nothing in either Peters or Besnard discloses, suggests, teaches, or motivates in the direction of this aspect of applicants' claimed invention.

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Still further in that same paragraph, the Office Action assumes:

In view of the patent of Besnard it would have been obvious to modify the set of irons of Peters to have a volume of the recess being between .4 and 5% of the volume of the head in order to have a sufficient amount of weight removed from a top of a head to lower the center of gravity a sufficient distance.

Office Action, 12/2/03, page 5. Again, this is the limitation of applicants' claim 8, which the Office action admits is not present in Peters, and admits is not disclosed in Besnard. There simply is no disclosure, teaching, suggestion or motivation in either Peters or Besnard to modify any portion of either reference to render obvious this aspect of applicants' claimed invention.

There is no disclosure, teaching, suggestion or motivation in either Besnard or Peters which would have made it obvious to modify Peters' irons to have at least one recess in the upper wall thereof. And, there is nothing in either reference which would in any way suggest modifying the other reference so that the volume of any such recess in the upper wall varies from one iron to another within the set causing the center of gravity of each club head in the set to vary in distance relative to the



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upper face from one iron to another. The Office Action simply erroneously and unlawfully assimilates applicants' disclosed and claimed invention into the prior art, with no basis for doing so in the prior art itself.

For all the foregoing reasons, reconsideration and withdrawal of these grounds of rejection are respectfully requested.

2. Claims 7 and 15 were rejected under §103(a) over Peters in view of Besnard, further in view of Japanese Patent Application Publication 7-213656 and Fenton U.S. Patent 5,290,036.

Claim 7 is dependent upon independent claim 1, and claim 15 is dependent upon claim 7. Accordingly, both claims 7 and 15 are patentable for the same reasons that independent claim 1 is patentable, as explained above herein. And, there is no disclosure or teaching in either JP '656 or Fenton that in any way supplies the deficiencies in either or both of Peters and Besnard.

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For all the foregoing reasons, there is no disclosure or teaching in any of Peters, Besnard, JP '656 or Fenton which discloses or teaches all the elements of any of applicants' claims. Further, there is no disclosure, teaching, suggestion or motivation in any of those references which suggests the desirability of combining any portions thereof effectively to anticipate or suggest applicants' presently claimed invention.

For all of the foregoing reasons, all claims 1, 7, 8, 11, 12 and 15 are patentably distinguished over all grounds of rejection cited in the Office Action. Accordingly, allowance of all claims 1, 7, 8, 11, 12 and 15 is respectfully solicited.


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Should the Examiner deem that any further amendments would be desirable in placing this application in even better condition for issue, he is invited to telephone applicants' undersigned representative.

Respectfully submitted,

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